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**MAR 16 2005**

**OFFICE OF PETITIONS**

In re Application of  
McCloy. :  
Application No. 09/495,105 :  
Attorney Docket No. 8044-000026(Q-99021) :

This is a decision on the petition filed on 19 February, 2004, alleging unintentional delay under 37 C.F.R. §1.137(b).

The Office regrets the delay in addressing this matter, however, the petition was received in the Office of Petitions only at this writing.

For the reasons set forth below, the petition under 37 C.F.R. §1.181 is **DISMISSED**; and the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

**BACKGROUND**

The record reflects that:

- Petitioner failed to reply timely and properly to the Decision of the Board of Patent Appeals and Interferences (BPAI) mailed on 27 August, 2003, affirming final Office action of the Examiner, with reply due on or before 27 October, 2003, and the BPAI did not permit extension of time under 37 C.F.R. §1.136(a);
- on 28 October, 2003, Petitioner filed (over an October 24, 2003, certificate of mailing) an

amendment after the final action of the BPAI, but did not file a Request for Continued Examination (RCE) (with fee and submission) under 37 C.F.R. §1.114;

- on 15 December, 2003, the Examiner mailed an Advisory Action indicating that the amendment would not be entered because it raised new issues requiring further consideration and search;
- it does not appear that the Office mailed the Notice of Abandonment before the instant petition was filed;
- it further appears that Petitioner filed a request for Status on 26 August and 29 December, 2004;
- Petitioner requests withdrawal of the holding of abandonment, or, alternatively, seeks revival as abandoned due to unintentional delay, and submits an RCE, fee and submission as the required reply, and makes the statement of unintentional delay.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

Allegations as to the Request to  
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>7</sup>

Petitioner contends that the burden for advancing the prosecution of Petitioner's application fell to the Examiner, and seeks support in the commentary at MPEP §1214.06. However, the MPEP clearly states therein: "Claims indicated as allowable prior to appeal except for their dependency from rejected claims will be treated as if they were rejected."

Petitioner could have permitted the Examiner to allow the claims not rejected under an Examiner's amendment or to set a period for Petitioner to amend properly.

Alternatively, Petitioner's proper reply following the decision of the BPAI would have been to file an RCE (with fee and submission) under 37 C.F.R. §1.114.

Instead, Petitioner chose to file an amendment which the Examiner found not to have placed the application in condition for allowance.

Petitioner wants to be able to continue prosecution without following the procedure for that process. Such is not grounds for withdrawal of the holding of abandonment.

Thus, Petitioner fails to carry his burden as to this argument.

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<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>7</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Allegations as to Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a showing/statement of unavoidable delay, a proper reply, and—where appropriate--a terminal disclaimer and fee (if the application was filed before 8 June, 1995).

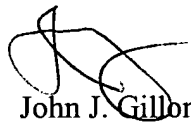
Petitioner has satisfied the requirements of the regulation

CONCLUSION

The petition under 37 C.F.R. §1.181 is **dismissed**; and the petition under 37 C.F.R. §1.137(b) hereby is **granted**.

The application is released to Technology Center 2800 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



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Office of Petitions